

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte GAVIN L. DOUGLAS

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Appeal No. 1996-3750  
Application No. 08/321,058

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ON BRIEF

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Before KRASS, BARRETT, and RUGGIERO, Administrative Patent Judges.

KRASS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 3-5, 10-12, 15-17 and 22-24. Appellant does not appeal the final rejection of independent claims 1, 2, 13 and 14, nor

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does appellant appeal the final rejection of claims 6-9 and 18-21.<sup>1</sup>

The invention pertains to word processing in general and to annotation in a side margin of a word processing object in particular. Claims 3 and 15 relate to aligning the annotation with a selected location and moving a portion of the annotation to the next page. Claims 4 and 16 relate to adding space in the body of the object in order to maintain alignment of the annotation and the selected location after a revision of the body. Claims 5 and 17 relate to the problem of overlap of annotations when a single line in the body may have more than one annotation associated with that line. Claims 10 and 22 relate to formatting an annotation independently of the body. Claims 11 and 23 relate to setting a particular format for the annotation. Claims 12 and 24 relate to locating a plurality of annotations in alternating right and left side margins of sequential pages of the body.

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<sup>1</sup>An amendment, filed October 11, 1995 (Paper No. 6), attempted to cancel claims 3, 6-10, 15 and 18-22, while amending claims 1, 2, 4, 5, 11-14, 16, 17, 23 and 24, but the amendment was refused entry by the examiner.

Representative claims 2, 3, 4 and 5 are reproduced as follows:

2. A computer implemented method of annotating a word processing object on a data processing system, said word processing object having a body with at least one side margin, comprising the steps of:

- a) selecting a location in said body of said word processing object;
- b) associating an annotation with said location;
- c) providing said word processing object to an output means with said annotation being located in said side margin and adjacent to said selected location in said body of said word processing object;
- d) revising said body; and
- e) after revising said body, aligning said annotation with said selected location such that said annotation remains adjacent to said selected location and in said side margin.

3. The method of claim 2 wherein said step of aligning said annotation with said selected location, further comprises the step of moving a portion of said annotation to a next page.

4. The method of claim 2 wherein said step of aligning said annotation with said selected location, further comprises the step of adding space in said body so as to maintain the alignment of said annotation and said selected location.

5. The method of claim 2 further comprising the steps of:

- a) determining if two selected locations are contained in a single line of said body; and
- b) if two selected locations are in a single line of said body, moving at least one of said annotations associated with said two selected locations in said side margin within a predetermined number of lines of said body so that said annotations can be read without overlap.

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The examiner relies on the following references:

Barker et al. (Barker)	4,974,194	Nov. 27, 1990
Norwood	5,063,600	Nov. 05, 1991
Cassorla et al.(Cassorla)	5,146,552	Sep. 08, 1992

Claims 1 through 24 stand rejected under 35 U.S.C. § 103 as being unpatentable over Norwood and Cassorla in view of Barker.

Reference is made to the brief and answer for the respective positions of appellant and the examiner.

#### OPINION

Since appellant does not appeal the rejection of the independent claims, we assume that appellant does not dispute the examiner's application of the prior art against the subject matter of these claims. Accordingly, we concentrate on the limitations added to the independent claims by claims 3-5, 10-12, 15-17 and 22-24.

With regard to claims 3 and 15, these claims further limit the step and means for aligning the annotation with the selected location to "moving a portion of said annotation to a next page." While the applied references are all directed to making annotations in a word processing document, none of these references discloses or suggests "moving a portion of said annotation to a next page" in keeping the annotation aligned with the selected portion of the body of the word processing object.

The examiner contends that since Cassorla mentions that the annotations are "strongly bound" to the structure relative to which the annotation is positioned [column 3, lines 46-49], movement of the annotation to a next page "would have further indicated the bounded nature of the annotation with the associated text" [answer-page 4]. We disagree. We find no nexus between Cassorla's recitation of annotations being "strongly bound" to a structure and the examiner's conclusion that this would have led the artisan to provide for "moving a portion of said annotation to a next page," as recited in claims 3 and 15. The examiner has provided absolutely no evidence of a suggestion by the applied references to split an

annotation between pages in order to keep an annotation aligned with a selected location in the body of the word processor object. Accordingly, there is no prima facie case of obviousness established with regard to the subject matter of instant claims 3 and 15 and we will not sustain the rejection of these claims under 35 U.S.C. § 103 based on the evidence supplied by the examiner.

Turning now to claims 4 and 16, these claims add the limitation of adding a space in the body so as to maintain alignment of the annotation with the selected location. We find no such teaching or suggestion in any of the applied references. The examiner, again, relies on the "strongly bound" language of Cassorla for a conclusion of obviousness because "adding space so as to maintain the alignment would have further indicated the bounded nature of the annotation with the associated text" [answer-page 5]. The examiner further contends that it "is well-known" [answer-page 11] to add or delete space for aesthetic and practical document layout and it would have been obvious "to have incorporated the addition of space in order to provide alignment of an annotation and its proper selection location" [answer-page

11]. However, the examiner has pointed to nothing in the applied references which would have led the artisan to "add space so as to maintain the alignment...", as claimed. The examiner's conclusion of obviousness appears to be based on pure conjecture and hindsight with no evidence to support the conclusion that it would have been obvious, within the meaning of 35 U.S.C. § 103, to provide for the addition of space in the body of the word processing object so as to maintain the alignment of the annotation and the selected location. Thus, we will not sustain the rejection of claims 4 and 16 under 35 U.S.C. § 103 based on the evidence provided by the examiner.

Claims 5 and 17 relate to the situation where there are annotations associated with two selected locations contained in a single line of the body wherein at least one annotation is moved within a predetermined number of lines of the body so that the annotations do not overlap. The examiner contends [answer-page 11] that it would have been obvious "that some particular thing, most obviously one of the annotations, must be moved in order to allow the user visual and functional access to the two annotations." The examiner's rationale appears to be based on hindsight gleaned from appellant's

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disclosure since there is no indication in the four corners of any of the references of the limitation set forth in claims 5 and 17. Accordingly, we will not sustain the rejection of claims 5 and 17 under 35 U.S.C.

§ 103.

We turn, now, to claims 10 and 22. These claims call for "formatting said annotation independently of said body and providing said word processing object to said output means with said formatted annotation." In order to provide for this limitation, the examiner relies on Norwood's disclosure, at column 12, lines 5-10, that a user "may not annotate throughout the body of the text but may write notations above and aside the text window." The examiner concludes from this that the annotated note in Norwood is formatted independently. The examiner also contends [answer-page 11] that "it is well-known in the art that portions of documents may be separately formatted..." We do not consider the handwritten notations in Norwood to be "formatting," as claimed, since formatting requires the ability to change things such as fonts, line spacing, line density, etc. There is no formatting of an annotation independent of the body of the word processing



object in Norwood, or in Cassorla or Barker for that matter, as claimed. While, it may be "well-known" that portions of documents may be separately formatted (e.g., different paragraphs in a document may have different fonts), the examiner has proffered no evidence that it would have been obvious to format an annotation separately and independently of the body of a word processing object where such annotation is in typed form and is located in a side margin and adjacent to a selected location in the body of the word processing object. Accordingly, we will not sustain the rejection of claims 10 and 22 under 35 U.S.C. § 103.

Claims 11 and 23 depend from claims 10 and 22, respectively. Therefore, since we have not sustained the rejection of claims 10 and 22, we also will not sustain the rejection of claims 11 and 23 under 35 U.S.C. § 103 based on the same prior art references.

Claims 12 and 24 recite that the body is segmented into pages and that a plurality of annotations is located "in alternating right and left side margins on sequential pages." The examiner relies on Figure 2 of Barker showing an annotation in a left side margin and concludes therefrom that

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it would have been obvious "to include a right side margin as well since the paper documents that these computer related inventions emulate were known to have both right and left margins" [answer-page 9]. The examiner also states, at page 12 of the answer, that "annotations within the left or right margins would be equivalent, and the aspect of alternating between margins merely provides enhanced readability." It is clear, once again, that the examiner's conclusions can only be based on impermissible hindsight gleaned from a reading of appellant's own disclosure since there is not one scintilla of evidence within any of the applied references that would support a finding of obviousness of the instant claimed subject matter. None of the references suggests, in any way, that a plurality of annotations should be located "in alternating right and left side margins on sequential pages." While it may be an easy thing to do once the artisan is told what to do, as by appellant's disclosure, there is no suggestion by the prior art of record for providing annotations in such an alternating fashion. We will not sustain the rejection of claims 12 and 24 under 35 U.S.C. § 103 based on the evidence provided by the examiner.

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The decision of the examiner rejecting claims 3-5, 10-12,  
15-17 and 22-24 under 35 U.S.C. § 103 is reversed.

REVERSED

ERROL A. KRASS	)	
Administrative Patent Judge	)	
	)	
	)	
	)	
	)	
LEE E. BARRETT	)	BOARD OF PATENT
Administrative Patent Judge	)	APPEALS AND
	)	INTERFERENCES
	)	
	)	
	)	
JOSEPH F. RUGGIERO	)	
Administrative Patent Judge	)	

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